

REMARKS

STATUS OF CLAIMS

Claims 1-12, 31- 41,60-140 are presently pending.

Claims 13-30, 42-59 and 128 have been previously cancelled.

Original claims 1 and 12 are amended herein and original claim 3 has previously been amended.

By the foregoing amendment, previously submitted claims 31-33, 36, 60-78, 81, 86, 97-105, 109,112, 114-118, 124, 127, 129-132, and 134 are currently amended.

Claims 136-140 are new claims.

INITIAL COMMENTS REGARDING THE BOARD DECISION

As noted hereinabove, applicants, pursuant to the option set forth by the Board on page 51 of the Board's decision, hereby elect to proceed before the Examiner for further prosecution of the merits.

In view of the reopening of prosecution, applicants have further amended the application.

In the "new grounds of rejection" of the previous original claim 12 (beginning on page 35 of the decision) the Board apparently suggests by use of the term "sic" that they believe there may be some antecedent basis irregularities in original claim 12, thought no rejection under any section of 35 U.S.C. 112 has been made by the Board.

As original claim 12 was originally pending in the 08/715,232 application (from which the patent being reissued matured) it forms a part of the original disclosure of the application.

Accordingly, Applicants have amended the present specification to include the subject matter of original claim 12 therein. Such amendment of the specification does not introduce new matter into the application and clearly provides support for each and every recitation of original claim 12.

Furthermore, with regard to the “claim interpretation” of claim 12, as set forth by the Board, beginning on page 36 of the Board’s decision, the Board argues that there is no specific structure to a “door” which appears in the body of the claim.

Applicants respectfully disagree. As noted in line 2 of original claim 12 it is stated that “said door comprising” followed by the structural limitation of the door. Such structural limitation of the door can clearly be found in the original disclosure as claim 12 was both an original claim and thus part of the original disclosure and has now been added to the specification, without introducing new matter into the application. Accordingly the specification clearly supports each and every limitation of claim 12 and clearly sets forth the limitation of the door. For example, Applicants respectfully direct the Examiner’s attention to the specification beginning at column 4, lines 42 wherein it is stated that “the vending machine door 100...is constructed as a retrofit to an existing vending machine. In this embodiment, the computer assembly 158 and money acceptor 152 are mounted in the door...”. Additionally although the Board noted(in the first two lines of page 37 of the Board’s decision), that “we do not find an adequate description of at least a modem that forms part of a door,” Applicants respectfully direct the Examiner’s attention to page 8, lines 16- 18 of the specification wherein it is stated that “the computer 400 includes a modem...”. Thus it is clear that the computer 400, which includes a modem, is in fact also present on and forms part of the “door.”

However notwithstanding the forgoing comments, Applicant has further amended original claim 12 to now recite a “retrofit door assembly for retrofitting an existing vending machine...said” retrofit door assembly comprising...”. Applicants respectfully submit that the forgoing amendments to original claim 12 should prevent the erroneous claim interpretation of claim 12 made by the Board As claim 12(amended) is substantially the same form as originally issued, no intervening right should accrue.

Although the undersigned does not want to provide any unnecessary documents to this already voluminous record, if the Examiner believes that providing a copy of the complete prosecution history of patent application 08/715,232(or any selected excerpts thereof) are necessary to establish that claim 12 is part of the original disclosure the Examiner is invited to contact the undersigned and applicants will supplement this response to include all, or a portion of such prosecution history, of the patent application which matured in the patent being reissued.

Applicants have similarly amended original claim 1 of the patent to positively recite a “retrofit door comprising...”as antecedent basis for the language of the retrofit door being clearly found in the original disclosure, for example in the amended portion of the specification, as noted above, as well as at column 4, lines 42 to column 5, lines 5 and Figures 1-3; as to the retrofit door(See column 4, lines 47-49), the computer assembly 158 and money acceptor 158 (column 4, lines 49-50) the video screen (column 4, lines 53-55) for the customer-two way interactive communication function (column 4, lines 55-56) and the keypad 118 and trackball 117 connected to computer assembly 158 (column 5, lines 12-25). Thus, it is clear that independent claim 1(and claims dependent thereon) includes are fully supported by the original disclosure.

Notwithstanding the forgoing, applicants have amended independent claim 1 to recite the aspects of the retrofit door in the body of claim to avoid the Board’s erroneous interpretation of the claimed invention and the nature of the retrofit door which is fully supported by the original disclosure of the application which matured into the patent being reissued.

THE PRESENT STATUS OF REJECTIONS

The Board reversed several rejections, sustained others and made new rejections such that all previous claims now stand rejected. A summary of the status of the claims is attached in the claims status as an attachment to this response.

NO RECAPTURE

The forgoing reissue application avoids the application of the recapture doctrine to the instant claim.

As previously noted by the Examiner, for example, in the final rejection of December 2, 2004, “improper recapture of broadened claimed subject matter [is that subject] surrendered in the application for the patent upon which the present reissue is based”, paragraph 1 of the final rejection.

However as noted hereinabove, patent claim 12 is an original claim of the patent application which was never amended (nor was there any argument) for the patentability of this claim as this claim was allowed in the first Office Action. Thus, there was no subject matter surrendered in order to obtain allowance of claim 12.

While the Examiner has erroneously equated “reasons for allowance” with “surrendered subject matter” he has cited to no authority which shows that such is in fact equivalent. Applicant did not surrender any subject matter, either by amendment and/or argument for patent claim 12. Accordingly, as patent claim 12 has no surrendered subject matter, Applicants can cancel the individual limitations from claim 12 as they see fit without raising the issue of surrendered subject matter, and hence improper recapture, from deletion of elements of claim 12. This Applicants have done by presentation of new claims 138 to 140 as will be discussed hereinbelow.

While, at oral hearing,(See transcript of hearing mailed October 17, 2008, as discussed beginning at page 2, line 19 to page 3, line 7 the “Honeywell” case referred to at page 2, line 7 is believed to be Honeywell International Inc. v. Hamilton Sundstrand Corporation, 370 F3d1131(Fed.Cir.2004) the court addressed a “presumption of surrender by referring *Festo* (*Festo Corp. v. Shoketsu Kinzoku Kabushiki Kogyo Co.*, 535 U.S. 722, 122 S.Ct. 1831, 152 L.Ed. 2d 944 (2002) in which the Federal Circuit stated that “in *FESTO* the Supreme Court held up the proper focus is whether the amendment narrows the overall scope

of the claimed subject matter.” See 535U.S. at 736-37, 122 S.Ct. at 1831; *Honeywell*, at 1141.

Because it is clear that patent claim 12 is broader than original application claim 1(which was amended), the amendment of application claim 1 did not narrow the overall scope of the patent. Thus, there is no recapture even when Applicants begin to delete claim limitations from original claim 12, thereby even broadening the scope of the patent beyond the limitations of the original patent claims because to do so has nothing to with surrendered subject matter. Applicants again remind the Examiner that according to both The Supreme Court and the Federal Circuit, surrendered subject matter only occurs when the overall scope of the patent is diminished and such an occurrence did not happen here when the original Examiner allowed patent claim 12, without amendment or argument. Although the Examiner notes (page 4 of the final rejection dated December 2, 2004, that he believes that “claims as broad or broader than the scope of original claim 1 are then surrendered subject matter and can not be recaptured” he completely ignores the reasoning of the Federal Circuit and The Supreme Court as noted above.

Original claim 1 was always narrower than patent claim 12 as being directed to a combination of a vending machine and door whereas patent claim 12 is directed to a sub-combination, i.e. a door itself. Thus, the fact that Applicants amended the recitation of the vending machine in the combination claim of claim 1 did not in any way limit the sub combination (patent claim 12) and the prosecution history of the patent application which matured into patent being reissued bears out. Again, should the Examiner wish to have a copy of the prosecution history of the patent application, which matured into the patent being reissued made a part of this record, he is requested to contact the undersigned and requesting that such a copy of such prosecution history be made of record in this application.

Before turning to the individual rejections either as affirmed by the Board or the new rejections as made by the Board, Applicants wish to mention the Sokal reference (U.S. Patent

5,953,504) and applicants' attempt to antedate this reference under the provisions of 37 CFR 1.131. The Board affirmed Applicants' right to employ the procedure 37 CFR 1.131 to antedate the Sokal reference (See page 19 of the Board's decision), and also agreed with Appellants that "a day-to-day summary is not required" (page 24, 13-14 of the Board's decision). However, as pointed out at oral argument and noted by the Board in the paragraph bridging pages 23-24 of the Board's decision, the Board was advised that the Examiner found that Appellants had established reasonable diligence during a six-month period between March 19, 1996, and September 18, 1996, but "we [the Board] had been unable to find the evidence which supports the Examiner's findings". While the Examiner's personal involvement and knowledge supported such facts, Applicants provide herewith a Declaration of James A. Satchell Jr., providing a day to day summary of activities during this entire time period of March 19, 1996 and September 18, 1996 to place such facts on the written record. As it is believed that the Examiner is personally aware of the facts set forth by the applicant, James A Satchell Jr., the written record had now been supplemented with a day to day summary within this time period.

It is therefore requested that Examiner review and confirm his previous findings that Appellants had established reasonable diligence in the time period between March 19, 1996, and September 18, 1996.

RECONSIDERATION OF THE CURRENT REJECTIONS

Reconsideration of the previous rejection of claim 130 under 35 USC102(e) over Sokal is respectfully requested.

The Board made this rejection, beginning at page 27 of the Board's decision, and the Examiner's attention is directed to that portion of the decision for a statement of the rejection.

The Board found that "the Sokal terminal" is also "vending machine" to dispense an article to be purchased by a consumer, because "software" can be purchased and downloaded

to the consumer's memory device, citing Sokal, column 1, lines 38-43; column 6, lines 44-48. The software itself—the data recorded on the consumer's memory device – is an “article”, for all claim 130 requires. Applicants can find no recitation of vending “software” in the Sokal disclosure.

Nonetheless, by the foregoing amendment, Applicants have amended independent claim 130 to recite that the vending machine is provided to dispense at least one article selected from the group consisting of cans, bottles, drinks and cups, sandwiches, candy and combs, none of which are found in the Sokal reference. Furthermore, independent claim 130 has been amended to recite that “vending machine comprising a storage device for the at least one article, and a dispensing mechanism for the at least one article, the vending machine being further provided with a door through which at least one article is dispensed; and the door further incorporating a two-way interactive consumer accessible internet communication system to permit the customer access to websites of the customer's choice. None of the limitations added in amended independent claim 130 are found on the Sokal disclosure.

For example, if the Board considers that the “software” is the “article” to be purchased, neither Sokal column 1, lines 38-43; nor column 6, lines 44-48; nor indeed any part of Sokal et al., teaches that the terminal, which vends the article “software” comprises a “storage device” for the at least one article [the software] as now recited in claim 130. Furthermore, most importantly the claimed method requires that the vending machine being provided with a door through which the at least one article [cans, bottles, drinks, and cups sandwiches, candy or combs] is provided. This is admittedly missing in Sokal because the Board has not pointed to, nor can the undersigned find, any “door” in the access terminal of the Figs. 2 or 3 of Sokal. As described by Sokal “the terminal of Figs. 2 and 3 comprises a secure housing 20 which contains all of the elements of the terminal so as to prevent unauthorized access” column 3, lines 51-53. There is no express disclosure of a door

through which an article to be vended is dispensed. Thus, the rejection of claim 130 under 35 USC 102(e) as being anticipated by Sokal has been overcome.

Reconsideration of the previous rejections of claim 130 over Huegel, or alternatively over Lockwood, both under 35 USC 103(a), are respectfully requested.

These rejections were sustained by the Board on pages 28-30 of the Board's decision.

Lockwood (US reissue patent Re.32,115) teaches a self service terminal for dispensing voice and video information, printed documents and goods according to the abstract, lines 1-2, with the "goods" being further described as travel guides, maps, sunglasses, foreign currency..." being described at 3, lines 47-50. Lockwood does not teach providing a vending machine to dispense at least one article selected from the group consisting of cans, bottles, drinks, and cups, sandwiches, candy and combs, as recited in amended independent claim 130.

Nor is there is any disclosure of a dispensing mechanism for cans, bottles, drinks, and cups, sandwiches, candy or combs, nor providing a delivery port in the door, which such can be dispensed.

As described by Lockwood himself, both in the drawings and according to the specification, "there is shown a self-service terminal 1 which is housed in a spherical enclosure 2 supported on a pedestal 3. A transparent plexiglass door 5 covering approximately one quadrant of the upper hemisphere pivots around a hinge 7 located at the apex. The door 5 gives access to a cavity in which a various control elements of the terminal are grouped." See column 2, lines 46-57. Thus, it can be seen in Lockwood there is no delivery port in a door through which cans, bottles, drinks, cups sandwiches, candy and combs can be dispensed. Thus, Lockwood clearly lacks the disclosure, either expressly or inherently, to establish each of the claimed features set forth in independent claim 130, and cannot establish a *prima facie* case of obviousness by itself for such claim.

Similarly, the Huegel reference (U.S. Patent 5,239,480) is said to describe a self-service terminal (Fig 1) that is part of an automatic ticket dispensing system. This rejection is outlined by the Board on page 14 of the Board's decision.

However, like Lockwood, Huegel lacks any discussion of a vending machine provided to dispense at least one article selected from the group consisting of cans, bottles, drinks in cups, sandwiches, candy and combs, nor any dispensing mechanism for such articles, nor the provision of a delivery port in a door through which such articles are dispensed. In fact Huegel lacks any teaching of a physical structure of the self-service terminal described in his disclosure as it relates to a dispensing mechanism and/or a dispensing port in a door. While it is stated that "in accordance with the invention, there provided a plurality of stations, for dispensing tickets for events..." column 4, lines 61-67; there are no descriptions of the terminal itself, and no description of the dispensing mechanism, nor the provision of a door in the self-service terminal, nor the provision of a delivery port in the door of the device of Huegel. Thus, Huegel clearly lacks a teaching of the claimed features of amended claim 130 and fails to establish a *prima facie* case of obviousness for amended claim 130. Withdrawal of these rejections under 35 USC 103(a) are respectfully requested.

Reconsideration of the rejection of claims 31-41, 60-64, 66, 68, 69, 71-108, 110-112, 127 and 129-134 under 35 USC 103(a) as being unpatentable over Bradt and Sokal is respectfully requested. This rejection is set out by the Board, beginning at page 30 of the Board's decision. Claims 31, 97, 100, 112 and claim 127 are each independent and each have been amended.

Cognizant of the Board's remarks regarding the term "retrofit door", applicant has amended independent claim 31 to recite a "retrofit door assembly for retrofitting an existing vending machine for dispensing at least one item selected by a customer wherein said retrofit door assembly comprises a door having a video screen operatively connected to the Internet

whereby a customer may view website content on said video screen”. Support for such an amendment is found throughout the specification, for example, in Figs. 1-3 where video screens 101, 201, and 301, respectively, are shown on the door and in the specification, for example, at column 4, lines 47-60. In addition, an access portal to the Internet on the door for interaction of the customer with the Internet so that the customer may choose a website to view on the video screen is also disclosed in this portion of the specification, for example, at column 4, lines 56-63; as well as column 9, lines 10-13 and 39-47. Moreover, independent claim 127 has also been amended to recite a method for creating greater patronage to a vending machine for drinks, with support for such amendment being found at column 1, lines 62-67. In addition claim 127 also requires the “retrofit door assembly”, wherein the retrofit door assembly “comprises a door with a video screen, at least one of a credit card reader or a money acceptor” with support for this limitation also being found in Figs 1-3, as well as the specification at column 5, lines 49-55. Claim 127 further requires at least one of a keypad, mouse, or trackball on the door allowing a customer to engage in interactive visual communication with the video screen that displays both the predetermined website and the website of the customer’s own choosing.

[THIS PORTION INTENTIONALLY LEFT BLANK]

Support for such limitations are also found in the drawings, for example, Figs 1-3, as well as the aforementioned portion of this specification at column 4, lines 49-55. Disclosure of the keypad, trackball, and mouse can be found in the original specification and also in the drawing Figs. 1-3, as well as column 5, lines 12-25; and column 7, lines 23-31. Claim 127 continues that “upon actuation of the money acceptor or credit card reader in an amount required to vend a drink the customer is automatically connected to a predetermined website, displaying the website on the video screen; and vending the drink...”, with support being found at column 8, lines 32-46 of the specification. Such a sequence of events are not at all contemplated by the combination of references mentioned by the Board in their decision as as will be further discussed below. In addition claim 127 permits a customer access to websites of the customer’s choice by the payment of an additional amount in excess of an amount required to vend the drink, which customer’s choice of website are also displayed on the video screen, with support being found in the specification at page 9, lines 10-20, and 34-49. Rather, the combination of Bradt and Sokal contain no teachings of this sequence of events, nor even the events in the aggregate, and thus, cannot make obvious the limitations of independent claims 31 and 127 and , by implication (35 USC 112 forth paragraph) any of the claims directly or indirectly dependent thereon.

While the Board noted that Appellants do not argue that “Internet” has a meaning distinguished from “internet” Applicants have amended independent claim 31 to require “websites” and thus makes the Board’s comment irrelevant. Similarly claim 127 also requires the customer to access “websites of the customer’s choice” which is nowhere shown in Bradt. In Bradt, the vending machine is connected to a website (without permitting the customer the choice of website, or even the option of viewing the website on a screen) in order to check for verifying information, such as a credit card number, password or other security measure but CRT 24 (Fig 1) is nowhere disclosed to permit a customer to view any website. Furthermore, the claimed invention of Claim 31 (and claims directly or indirectly

dependent thereon) must include a retrofit door assembly for retrofitting an existing vending machine for dispensing of at least one drink selected by a customer and having a delivery port for dispensing set of at least one drink selected by a customer. Such deficiencies are not cured by combination with Sokal, because, in the words of the Board regarding Sokal (page 27 of the Board's decision) "Sokal's Fig 2 shows the receptacle 38 for printed sheets and a laser printer 37. Printed sheets (i.e. article) are vended because a user can utilize this desktop publishing software and the terminal to generate printed sheets...the Sokal terminal is also a "vending machine" to dispense an article to be purchased by a consumer because software can be purchased and downloaded to the consumer's memory device...the software itself—are recorded on a consumer's memory device—is a "article"...". However if either the "printed sheets" are considered to be the "articles to be vended" Sokal's Fig 2 shows the receptacle 38 for "printed sheets" to be at the top of the machine. On the other hand if the "software itself" is an article (applicants can find no disclosure in Sokal of vending software) there is also no disclosure of a delivery port for dispensing such "article" "in the door of a retrofit door assembly" as instantly claimed. By contrast, Sokal describes his terminal (illustrated in his Figs 2 and 3) as comprising "a secure housing 20 which contains all the elements of a terminal so as to prevent unauthorized access"; See column 3, lines 51-52. There is no door illustrated in the Figs, nor is any door mentioned in the body of the specification of Sokal. Thus, it would not have been obvious to provide a retrofit door assembly for retrofitting an existing vending machine in which said retrofit door assembly comprises "a door having a video screen" operatively connected to the Internet of by which a customer may view website content, nor the combination of a video screen and door as instantly claimed in independent claim 31(and claims 32-41, 60-64, 66, 68, 69, 71-108, 110-112, and 131-132 dependent thereon) as well as new claims 138-140. In addition, independent claim 127(upon which dependent claims 129-130 depend) has also been amended in a matter not at all contemplated by the proposed combination of Bradt and Sokal.

In claim 127, the method of attracting greater patronage to a vending machine is accomplished by a customer payment to a payment control device, said payment automatically connecting the customer to a predetermined website and permitting vending of a selected item while allowing a customer to interact with the payment control device to pay an amount more than the amount required to vend the selected item, and permit the customer to then select a website of his own choosing and to interact with such website of his choosing.

As noted hereinabove, the device of Bradt, including the CRT 24, does not permit a customer to view a website of his choosing, and in fact the machine does not permit the customer to view any website at all on CRT 24. The machine uses the security information provided by the customer, i.e., pin number, credit card, or other security information, in order to verify such security information within the sole control of a machine, and nothing else.

The combination of Bradt with Sokal also would not provide the teachings of the claimed invention, because of the Board's reasoning regarding the only "items" dispensed by the Sokal process would be the paper, through receptacle 38, or the "software" placed on a user's own memory device. However in the claimed invention, the method does much more. In the claimed method, upon the payment of an amount sufficient to vend the selected item a customer is automatically connected to a predetermined website, and the article for which payment has been received is then vended. Only thereafter does the customer have a choice of visiting other websites, by providing an additional amount (in addition to the amount already paid to vend the item) for access to websites of his choosing. The proposed combination of Bradt and Sokal does not perform this method, nor is it capable of doing so without the exercise of further invention, which is not at all taught by the proposed combination Bradt and Sokal. For the foregoing reasons, claims 127, 129, and 130 are also patentable over the proposed combination of Bradt and Sokal.

Although other independent claims were not specifically mentioned by number in the Board's decision, claims 97, 100, and 112 are also independent claims and each of these claims has been amended to more particularly emphasize the structure of a retrofitting door assembly. There is no teaching in either Bradt or Sokal, or the proposed combination of Bradt and Sokal, for the provision of a retrofit door assembly comprising a door wherein a computer is provided on a door.

As noted hereinabove, Sokal's terminal, as shown in Figs 2 and 3 of his drawings, comprises "a secured housing 20" and nowhere does Sokal describe a door. Since Sokal does not describe a door, it cannot reasonably be argued that Sokal teaches a computer on a door as part of a retrofit door assembly, as instantly claimed.

Similarly Bradt does not disclose a retrofit door assembly comprising a door comprising a computer as instantly claimed. Thus, the proposed combination of Bradt and Sokal still does not teach the claimed invention, and only by the impermissible use of hindsight, using Applicant own specification as a guide, could the instant invention be made obvious in view of the combination of Bradt and Sokal ***as further modified by the teachings of applicants' specification.*** The combination of Bradt and Sokal simply does not have the structure necessary to make obvious to claimed invention. Accordingly, each of claims 97-100 and 122 are also patentable over the proposed combination of Bradt and Sokal.

Reconsideration of the previous rejection of claims 65 and 70 as unpatentable under 35 USC103(a) over the combination of Bradt, Sokal and Brown is respectfully requested.

None of Bradt, Sokal and Brown, nor any possible combination of them, teach all of the limitations of the claims from which claims 65 and 70 depend as noted hereinabove. In addition, claim 65 requires that the door of the retrofit door assembly further comprises speakers. As the proposed combination of Bradt, Sokal and Brown does not show a retrofit door assembly, the mere inclusion of speakers on a vending machine, as in Brown, does not correct these forgoing deficiencies in a proposed combination of references. Additionally,

claim 70 further adds the limitation that the door of the retrofit door assembly further comprises a headphone. Since the proposed combination of Bradt, Sokal and Brown does not contain a retrofit door, the mere identification of headphones, as in the Brown reference, does not establish a *prima facie* case of obviousness for the specific structure and structural interrelationship of the claims of a retrofit door assembly wherein the door of a retrofit door assembly comprises a microphone. Accordingly, withdrawal of the rejections are respectfully requested.

Reconsideration of the rejection of claims 67 and 113 over Bradt, Sokal and Small as set forth on page 34 over the Board's decision is respectfully requested.

As noted above, these claims are also dependent on claims previously rejected over Bradt and Sokal alone. The mere citation of Small does not correct the deficiencies in the proposed combination of Bradt and Sokal and furthermore, the Board recognizes that "the Examiner's rejection does not rely on Small for teaching a door". Thus, there is clearly no correction of the deficiencies in failing to teach having a retrofit door assembly comprising a door as recited in the claims, from which claims 67 and 113 depend, by combination of Small with Bradt and Sokal, as Small has been recognized by the Board as not being cited to correct this deficiency. Further, even though Small teaches a mouse and a trackball as computer input devices, the claimed invention does not merely claim the use of a mouse and trackball as a computer input device, but rather, specifies a specific structure, i.e., a retrofit door assembly comprising a door which comprises either a trackball (claim 67) or a mouse (claim 113). Applicants are not merely claiming an aggregation, i.e., a collection of a number of individual discrete elements or parts, but rather claims the elements in a structural interrelationship, i.e. a trackball *on* a door of a *retrofit door assembly* which is not taught by the proposed combination of references. Withdrawal of the rejection is therefore requested.

Reconsideration and withdrawal of the rejection of claim 109 as unpatentable under 35 USC103(a) over Bradt, Sokal and Brandes, as in mentioned by Board on page 35 of the Board's decision is requested

While Brandes does teach a vending machine having a transparent or translucent display field on a sign panel to display a logo, as illustrated, for example, in Figs 1 and 2 of Brandes patent, claim 109 is dependent on claim 31 which has been rejected solely over the combination Bradt and Sokal. And in the combination of Bradt and Sokal there no retrofit door assembly comprising a door having the structural relationships claimed in claim 31. As Brandes is only cited to show the additional limitations of claim 109 and not cited to correct the deficiencies of the rejection of claim 31 over the combination of Brandt and Sokal the purported combination of Bradt, Sokal and Brandes as to claim 109 still does not establish a *prima facie* case of obviousness for the claimed invention. In addition, claim 109 has been further amended to require the presence of "at least one audio or video drive for transmitting customer data to a remote receiver", which is not found in any possible combination of these references. Accordingly, withdrawal of the rejection is respectfully requested.

THE NEW GROUNDS OF REJECTION

Reconsideration of the previous rejection of claims 1, 2 and 12 as anticipated under 35USC102(b) over Bradt, or alternatively under 35USC102(e) as anticipated by Sokal, is respectfully requested.

The Board made these new grounds of rejections beginning at page 35 of the Board's decision based upon an improper claim interpretation that the term "retrofit door" of claim 12 is not supported by the specification, as the Board alleged they were unable to find a description of the invention of claim 12 in the specification.

However, as was noted above, patented claim 12 is an original claim (claim 10 of the application from which the patent being reissued matured) and thus it forms part of the original disclosure. By the foregoing amendment to the specification, Applicant has inserted

the disclosure of original patent claim 12 (claim 10 of the application as filed) into the specification and such amendment is not new matter as it was part of the original disclosure.

Thus, the Board's entire misinterpretation of claim 12 is improper as claim 12 is clearly directed to a retrofit door. Moreover, claim 12 has been further amended so as to positively recite a "door" in the body of the claim, as well as in the preamble. However, as the preamble breathes life and meaning into the claim, the amendment does not change the scope of the claim. Furthermore, although the Board decision in the sentence bridging pages 36-37 states that they cannot find adequate description of a modem that forms part of a "door" the Examiner's attention is respectfully directed to the original specification, for example, column 8, lines 16-18 for this limitation where the specification states that "computer 400 includes a modem...", as well as column 4, lines 48-52, which states "the door 100 is constructed as a retrofit to an existing machine. In this embodiment, the computer assembly 158... are mounted on the door..." Thus it is clear that the modem can be part of the computer, and, in at least one particularly disclosed embodiment of the invention, is in fact disclosed as being in the door. Thus, the Board's interpretation of the claim as not covering a retrofit door is clearly erroneous.

Notwithstanding the foregoing, there is no possibility that claims 1, 2 and 12 are anticipated by either Bradt or Sokal.

Claim 12 is to a retrofit door whereas independent claim 1 (and claim 2 dependent thereon) are to a combination of a door and a vending machine. Sokal does not teach the existence of any door in his terminal. As described by Sokal in column 3, lines 51-55 the terminal shown in Figs 2 and 3 of Sokal "comprises a secure housing 20 which contains all the elements of a terminal to prevent unauthorized access". There is no mention of a door and clearly no mention of a door having the component parts as recited in claim 12, nor a door on a vending machine as recited in independent claim 1 (and claim 2 dependent thereon).

In order to constitute anticipation, a single reference must teach every element, either expressly or inherently, of the claim. As Sokal does not even mention the existence of a door it cannot be argued that Sokal must “inherently” have a door and clearly not a “door” having the structural components and structural interrelationship as recited in claims 1, 2, and 12.

Similarly Bradt, though showing a machine from which a customer can selectively purchase or rent a video cassette or other such product, e.g., blank video tapes, music discs and the like (abstract lines 1-3) Bradt does not teach any door as claimed in independent claim 12; or combination of a door and a vending machine as claimed in claims 1-2 which can meet all the limitations of the claims as set forth therein. While Bradt teaches, column 7, lines 32-51 a vending machine 10 comprising a cabinet 12 which in turn consists of a shell 14 and a door 16 which is hinged on long side of shell 14 to provide access to the interior of shell 14 from the front of cabinet 12, there is no teaching in Bradt that his door comprises “a storage unit”, a “dispensing mechanism”, a “computer assembly connected to the storage unit and dispensing mechanism”, or a “modem” as specifically recited in Applicant’s independent claim 12; nor the computer assembly connected to the storage unit and dispensing mechanism, selector device, and payment control device and having a computer video display screen and communication network all in the door as recited in independent claim 1; nor the modem that recited in independent claim 2. Thus, neither Sokal nor Bradt contains the teachings necessary to constitute an anticipatory reference under any of the provisions of 35USC102. Accordingly, withdrawal of the rejections are respectfully requested.

Reconsideration of the previous new grounds of rejection of claims 1-6 and 8-12 under 35USC103(a) over the “Admitted Prior Art”, Bradt and Sokal is respectfully requested.

Such rejections is mentioned by the Board beginning at page 41 of the Board’s decision. Although Appellants admit that home computers and internet access were well known, they deny that vending machines with interactive customer communication were well known at the time of the invention.(see the foot of page 41 of the Board’s decision).

Although the brief before the Board was written prior to the time of the Supreme Courts decision in *KSR* (2008) and there was some discussion with the Board concerning the language of the brief concerning motivation (see page 29 of the transcript of hearing) there was no admission by applicants that vending machines with interactive customer communication were well known at the time of the invention. However, such is not the claimed invention as found in the rejected claims 1-6 and 8-12. Rather, what is found in independent claim 1 and independent claim 12 is a retrofit door (claim 12) having a computer connected to a storage unit and a dispensing mechanism and a modem, all in the door which are nowhere found in the proposed combination of the “Admitted Prior Art”, Bradt and Sokal. Even if one was to take a home computer, internet access and a vending machine and “glue” them together, as suggested by the Board at the Oral Hearing, such would not be the claimed invention. Applicants’ claimed invention is to a specific structure which is nowhere shown by the proposed combination of references. The interaction between the elements, i.e., the placement of the computer, the modem, the storage unit and the dispensing mechanism on the door of claim 12, further where the computer assembly is connected to the storage unit and dispensing mechanism, as well as to a video display screen and a communication network, as in claim 1 on the door of a retrofit vending machine or a modem (claim 2) on the door are clearly are not found by any possible combination of the “Admitted Prior Art”, Bradt and Sokal. For the foregoing reasons, the Board’s rejection is not justified under 35USC103(a).

Reconsideration of the new ground of rejection of claim 7 as unpatentable under 35USC103(a) over the “Admitted Prior Art”, Bradt, Sokal and Small is also respectfully requested. Again the rejection of claim 7, beginning at page 44 of the Board’s decision, simply starts from the erroneous interpretation of the claim as not setting forth the elements which it clearly recites. Although this erroneous interpretation may have been caused by the Board’s failure to appreciate the prosecution history, in which it is clear the claim 12 was an

original claim, and thus constituted part of the original disclosure, it is clear that every part of claim 12 is fully supported by the original disclosure of the application. Once the specification has been amended, as in the current amendment, the specification clearly provides the written description for the claimed subject matter and it is clear that such subject matter is, as the Board noted “an important part of one embodiment of the invention” (page 36 of the Board decision). The similar recitation of claim 1, upon which claim 7 is dependent, specifically recites a retrofit door “comprising a computer assembly” which is nowhere found in the proposed combination of “Admitted Prior Art”, Bradt, Sokal and Small. Thus, claim 7, which depends from claim 1, is also allowable for the reasons that claim 1 is allowable and there is nothing in the “Admitted Prior Art” of column 1 of the 216 patent, Bradt, Sokal, and Small which makes claims 7 obvious. While claim 7 adds the additional limitation to the computer in the door of claim 1, including “user operated keypad and trackball for operation of said computer” Small teaches a “stand-alone kiosk housing incorporates a video monitor, an input alphanumeric keyboard, a credit card reader and/or cash receiving equipment” (column 2 lines 32-35), although a “CPU within the housing controls each of these devices...” column 2, lines 35-37, there is no teaching that such CPU is part of a door. In fact, there is no teaching that there is any door whatsoever in the disclosure of Small. The deficiencies of the prior combination, i.e., Bradt, Sokal and the “Admitted prior art” is not remedied by combination with Small as there is no teaching of the structural interrelationship of the claimed components as specifically recited, i.e., a door having a computer and various other components. At best, the Board is merely aggregating a list of parts, but there is no teaching of the Prior Art of the interrelationship of the parts as claimed. *KSR* was never intended to support a mere aggregation of individual parts as being sufficient to establish *apprima facie* case of obviousness for specific components arranged in specific structural interrelationships not found in the Prior Art. Where has the Board cited to any Prior Art reference in which a door has been provided with a computer and/or the other

recited components so as to permit a door to be retrofitted to an existing vending machine in order to change a function of the vending machine? While it is true that a home computer was known, and Internet access was known, where is the “door” on a computer? Though merely “glueing” a home computer, or an Internet terminal or kiosk to a vending machine, as suggested by the Board would not result in the claimed invention and therefore does not establish a *prima facie* case of obviousness even under **KSR**. There is no structural interrelationship between such “glued” components that will teach or make up the specifically claimed structure that Applicants claim. What the Board has lost sight of in the voluminous record, as is apparent from the new ground of rejection of the Examiner’s originally allowed claim 1-12, (which, until the Board’s decision were also allowed) is that the structural interrelationship of these specific elements of claims 1-12 were nowhere found in the Prior Art, or made obvious by any possible combination of references. Withdrawal of the rejections is therefore respectfully requested.

Reconsideration of the new grounds of rejection of claims 114-122 and 124-126 as being unpatentable under 35USC103(a) over Sokal, Bradt, and newly cited Mills (U.S. Patent 1,697,537) is respectfully requested. Independent claim 114 is exemplary. Claim 114 recites the provision of a vending machine to vend at least on physical item selected by a customer for purchase and the purchase of said at least one item permits the customer to be automatically connected by the Internet to websites and furthermore allows access to the websites by the customer’s choice with such access comprising at least one of inserting money or credit card information into the vending machine and customer input of data into the computer, which is not shown by any combination of Bradt, Sokal and Mills.

While the Board states (page 45 of the Board’s decision) that Sokal’s teaching suggests providing of a vending machine to vend at least two different physical items selected by a customer for purchase, such as paper and/or “software” Sokal does not contain any teaching of vending “software. However, the claimed invention it is not merely to provide a vending

machine to vend at least one physical item, but further that the purchase of the at least one physical item permits the customer to be operatively connectable via the Internet to a predetermined website. In the Sokal teaching, the connection to the “website” occurs prior to the “vending”, i.e., prior to the receiving of the paper from receptacle 38 (Fig 2 and column 5, line 17-23 (or alternatively to download “software”) column 6, lines 30-34 and 44-48. By contrast the invention as defined in claim 114 operatively connects the purchaser upon receipt of payment for the vended item to a predetermined website and thereafter permits the customer to visit websites of the customer’s choosing by the payment of an amount in excess of the amount of the vended item. This is completely contrary to the “vending” of paper (or software) in Sokal. In Sokal, the “vending “ occurs after the user has visited websites of his choosing. In the claimed invention, the vending of the at least one physical item occurs before the customer chooses which websites he wishes to view, which is contrary to the steps of Sokal. Bradt does not correct this forgoing deficiency, because Bradt does not permit access to any website at all by the customer. Rather, in Bradt the entry of security information, i.e., the pin number, credit card or other security information, connects the machine to a website to verify the information, but does not connect the customer to the website nor can the website be viewed by the customer. On the other hand, newly cited Mills, patented in 1929, is well prior to the advent of any computer and clearly well prior to the existence of websites. Rather, Mills is directed to a gambling machine, known commonly as “one-armed bandits” which has a “plurality of legend-displaying wheels which are adapted to be driven by actuating the machine, and which will, when they come to rest, display a combination of legends, or symbols, as for the purpose of telling fortunes, or for other purposes (page 1, lines 1-10). There is no computer in Mills and nothing that will permit the purchase of an item to operatively connect a customer, via the Internet, to websites. Thus, Mills cannot possibly correct the forgoing deficiencies of Sokal, even in combination with Bradt and thus does not establish a *prima facie* case of obviousness for the

claimed invention. Accordingly, withdrawal of the rejection of the claims is respectfully requested.

Reconsideration of the new grounds rejection of claim 123 as unpatentable under 35USC103(a) over Sokal, Bradt, Mills and PC Computing is respectfully requested.

While the Board states (on the top of page 47 of the Board's decision) that "Sokal does not teach anything to prevent such transmission) the teaching of a reference must be positive, and not negative, i.e., the absence of a teaching does not mean that because of the absence of a teaching, that it does permit something to be accomplished. Sokal contains no teaching that a customer transmits data on the Internet from the customer's own magnetic or optical storage mediums through a door of a vending machine. In fact, there is no teaching that Sokal contains any apparatus whatsoever that would read a customer's own magnetic or optical storage medium for the purpose of transmitting it. Rather the sole disclosure of Sokal is found in column 4, lines 3-6 in which it is stated that "insert slot section 25A at the surface of the housing for receiving CD's and for mastering such CDs from information supplied to the [mastering] unit 25", (Fig 2) will not permit and thus prohibits any reading of information from a customer own CD.

The newly cited document of the board, "Online Super Guide" was discussing "Online " services versus the web. At the time of publication of this article (February 19, 1996) "online" did not mean what it means today, especially when it was being compared to "the web". In fact one of the "online" services described was "America Online" which was not internet based at the time as could be seen from the first page of the article from PC Computing which compared the "online" services against a web connection with a local internet service provider. As set forth on page 119 of this article, under the heading "downloading files" one of the big draw of the "online services" had been their vast libraries of free software as provided by Compuserve, America Online, Prodigy, and Microsoft Network. By contrast, at the foot of the right hand column of page 119, it is said that

“Navigator gives you access to millions of files scattered across STP sites.” Thus, while the Board concentrated on email (foot of page 120) there is simply no mechanism in Sokal, Bradt, Mills, and the combination with PC Computing which would have permitted “downloading” an email file attachment from a customer’s own magnetic or optical storage medium through the result of the proposed combination of references. While such possibilities would quickly come in the not too distant future, at the time of the publication of PC Computing, even in light of Sokal, Bradt, and Mills, by this combination it simply was not possible to do what Applicants had done. Accordingly, withdrawal of the rejection is respectfully requested.

Applicants also attached a supplemental Declaration of one of co-inventors, James A. Satchell Jr., providing further evidence of reasonable diligence in a day-by-day format for the time period between March 19, 1996 and September 18, 1996.

The Declarant also presents additionally evidence concerning the 1995 hurricane Opal and the disruption caused on him personally during the time period as questioned by the Board on page 22 of the Board’s decision.


Having fully responded to the option of further prosecution before the Examiner, Applicants request a prompt Notice of Allowance.

For the foregoing reasons, favorable reconsideration and withdrawal of all the previous rejections and passage of the application to issue are respectfully requested.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 14-1437, under Order No. 8685.002.US0001.

Date: January 7, 2009

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'TP Pavelko', with a long horizontal flourish extending to the right.

Thomas P. Pavelko
Registration No. 31,689
NOVAK DRUCE & QUIGG LLP
1300 Eye Street, NW
1000 West Tower
Washington, DC 20005
Telephone: (202) 659-0100
Facsimile: (202) 659-0105

Rejections Reversed

102(c) rejection over Kolls of claim 130

102(b) rejection over Huegel of claim 130

102(b) rejection over Lockwood of claim 130

Rejections Sustained

102 (e) of claim 130 over Sokal

103 (a) of claim 130 over Hugel

103 (a) of claim 130 over Lockwood

103 (a) of claim 127 over Bradt and Sokal

103 (a) of claim 38 over Bradt and Sokal

103 (a) of claim 65 and 70 over Bradt, Sokal and Brown

103 (a) of claim 67 and 113 over Bradt, Sokal and Small

103 (a) claim 109 over Bradt, Sokal and Brandes

New Rejections

31-41, 60-64, 66, 68, 69, 71-108, 110-112, 127 and 129-134 under 35USC103(a) over Bradt and Sokal

1, 2 and 12 under 102(b) over Bradt

1, 2 and 12 under 102(c) over Sokal

1-6 and 8-12 under 103 (a) over “Admitted Prior Art”, Bradt and Sokal

7 under 103(a) over “Admitted Prior Art”, Bradt, Sokal and Small

114-122 under 124-126 under 103 (a) over Sokal, Bradt and Mills

123 under 103 (a) over Sokal, Bradt, Mills and PC company